A "new ground of rejection" is any new line of reasoning that requires a "fair opportunity to react to the thrust of the rejection." *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on new portions of the same references, for disclosure not found in portions previously relied on, is a "new ground of rejection." *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference," emphasis added). Any new reference is a new ground of rejection. *In re Ahlert*, 424 F.2d 1088, 1092 n. 4, 165 USPQ 418, 421 n. 4 (CCPA 1970) (any time a new reference is cited, "a new ground of rejection is always stated," emphasis added).

The Advisory Action introduces both a new reference and a new portion of a reference. The Advisory Action is the first time U.S. Patent No. 6,789,181 has been mentioned. This is a "new ground of rejection." Further, the Advisory Action is the first to identify any similarity between claim 1 of this application and any identified combination of claims 16, 18 and 19 of U.S. Pat. No. 6,789,181. This "different portion" of the '181 patent is likewise a "new ground of rejection."

Claim 1 of this application was not amended subsequent to the Office Action of December 30, 2004.

Any double patenting rejection raised in the Advisory Action is a "new ground of rejection" of an unamended claim.

Thus, under MPEP § 706.07(a), this new ground of rejection cannot be made final.

II. The Advisory Action Applies an Incorrect Test for Consideration of Applicant's Paper of February 28, 2004

The Advisory Action of March 28, 2005 has a check in the box for "The proposed amendment(s) filed after a final rejection... will not be entered because ... they raise new issues that would require further consideration and/or search." The Advisory Action does not check any box relevant to "Request for Reconsideration."

response to and including April 30, 2005. In this event, kindly charge the petition fee of $120.00 to Deposit Account No. 23-2405, Order No. 114596-20-4009.

REMARKS/ARGUMENTS

This paper responds to the Office Action of December 30, 2004 and the Advisory Action of March 28, 2005.[1]

Claims 1-59 and 61-65 are now pending, a total of 64 claims. Claims 1, 2, 14, 22, 30, 40, and 55 are independent.

I. Paragraphs 11-12: Double Patenting over Yates 6,397,379

Applicants paper of February 28, 2005 showed that no Office Action had been sufficient to raise any double patenting rejection over Yates 6,397,379.[2]

The Advisory Action of March 28, 2005 does not mention any double patenting rejection over the '379 patent. It is therefore assumed that any double-patenting issue relative to the Yates '379 patent is resolved.

If there is any remaining issue with the '379 patent, Applicant requests that the Examiner make the specific showings required by MPEP § 804(B)(1): (a) identify one claim of this application, and one claim of the '379 patent (not a combination of claims that do not depend on each other), and (b) make a showing that every limitation in the identified claim of this application is identical to or an obvious variant of the identified claim of the '379 patent. Without those showings, no rejection exists, let alone a final rejection.

---

[1] As noted in the accompanying "Request for Withdrawal of Finality of Office Action," finality of the December Office Action is premature.

[2] Applicant notes an error in the paper of February 28, 2005, and wishes to correct it. At page 2, the February 2005 paper comments that "neither 7 nor 8 depends on claim 4" – what was intended was that "neither claim 7 nor 8 depends on the other," and that there was therefore no legally permissible basis for combining these two claims.

II. Paragraph 13: Double Patenting over Yates 6,789,181

The Advisory Action discusses obviousness-type double patenting of claim 1 of this application over the combination of claim 19 (together with its parent claim, claim 16) of Yates 6,789,181.

Claim 1 of this application recites as follows:

> 1. A computer, comprising:
>
> a binary translator programmed to translate at least a segment of a binary representation of a program from a first representation in a first instruction set architecture to a second representation in a second instruction set architecture, a sequence of side-effects in the second representation differing from a sequence of side-effects in the translated segment of the first representation, the second representation distinguishing individual memory loads that are believed to be directed to well-behaved memory from memory loads that are believed to be directed to non-well-behaved memory device(s);
>
> instruction execution circuitry designed, while executing the second representation,
>
> to identify an individual memory-reference instruction, or an individual memory reference of an instruction, a side-effect arising from the memory reference having been reordered by the translator, the memory reference having been believed at translation time to be directed to well-behaved memory but that at execution time is found to reference a device with a valid memory address that cannot be guaranteed to be well-behaved, based at least in part on an annotation encoded in a segment descriptor, and
>
> based in the distinguishing, to identify whether the difference in sequence of side-effects may have a material effect on the execution of the program; and
>
> circuitry and/or software designed to establish program state to a state equivalent to a state that would have occurred in the execution of the first representation, and to resume execution of the translated segment of the program in the first instruction set.

The **first** error in the Advisory Action is its failure to make any showing that any of the three underlined claim limitations are either identical to or obvious variants of claim 19. The Action is simply silent on these three limitations. The Advisory Action is insufficient to raise any rejection at all, let alone a final rejection.

Second, the Advisory Action attempts to combine claim 18 of the '181 patent with claims 16 and 19. Neither claims 18 nor 19 is dependent on the other. If there is no claim "16 + 18 + 19" in the '181 patent, there is no "patenting" of such subject matter in the '181 patent, and

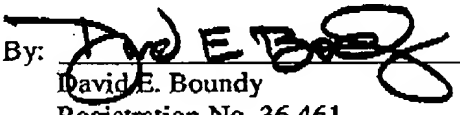
no "double patenting" here. The Advisory Action is insufficient to raise any rejection at all, let alone a final rejection.

For four separate reasons, no double patenting rejection has been raised over claim 19 of Yates '181. No terminal disclaimer is warranted.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-20-4009.

Respectfully submitted,
WILLKIE FARR & GALLAGHER LLP

Dated: April 14, 2005

By: 
David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8757
(212) 728-9757 Fax

Applicant's paper of February 28, 2005 was not an "amendment;" it proposed no amendment(s). It was only a Request for Reconsideration. The Remarks of February 28, 2005 and of the Request for Reconsideration filed herewith are entitled to full consideration.

III. Conclusion

For these reasons, the finality of the Action of May 10, 2002 should be withdrawn, and the Remarks in the accompanying Request for Reconsideration should be given the Examiner's full consideration.

In the event final rejection is withdrawn, the Information Disclosure Statement filed February 28, 2005 is entitled to consideration.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-20-4009.

Respectfully submitted,
WILLKIE FARR & GALLAGHER LLP

Dated: April 14, 2005

By: 
David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8757
(212) 728-9757 Fax